

## REMARKS

The Office Action mailed September 26, 2008, has been received and reviewed. Claims 1-17 and 29-36 are currently pending in the application. Claims 1-6, 8, 9, 12-17 and 29-36 stand rejected. Claims 7, 10 and 11 are objected to. Applicant has amended claim 34, and respectfully requests reconsideration of the application as amended herein.

No new matter has been added.

### 35 U.S.C. § 112 Claim Rejections

Claims 34-36 were rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. Specifically, claim 34 recites the limitation “the length of the dedicated orthogonal code” in lines 2-3, and “the length of at least one of the plurality of orthogonal codes” in line [6], and there is insufficient antecedent basis for these limitations.

Applicant has amended claim 34 to remove the lack of antecedent basis in the claims. Therefore, the rejection has been overcome. Accordingly, Applicant respectfully requests the rejection be withdrawn.

### 35 U.S.C. § 103 Obviousness Rejections

Claims 1-6, 8, 9, 12-17, 29-33 and 35 were rejected as being unpatentable over U.S. Patent 6,901,062 to Scherzer et al ( “Scherzer”) and U.S. Patent 6,870,824 to Kim et al ( “Kim”) in view of U.S. Patent 6,930,981 to Gopalakrishnan et al ( “Gopalakrishnan”). Applicant respectfully traverses this rejection, as hereinafter set forth.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, “[a] patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art . . . it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner

claimed. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1731, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant's disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

The 35 U.S.C. § 103(a) obviousness rejections of claims 1-6, 8, 9, 12-17, 29-33 and 35 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art references must teach or suggest all the claims limitations.

The Office Action concedes:

*Scherzer et al. and Kim et al. do not disclose determining whether to spread at least a portion of communications to said one of the subscriber stations with one of the orthogonal codes assigned to said one of the groups as a function of the data rate.* (Office Action, p. 4; emphasis added).

Applicant respectfully asserts that Applicant's independent claims 1, 6, 17 and 29, each recite in part, "*determin[ing] whether to spread at least a portion of communications to said one of the subscriber stations with one of the orthogonal codes assigned to said one of the groups as a function of the data rate*". Accordingly, Applicant's invention claims (1) "*orthogonal codes assigned ... as a function of the data rate*" and then (2) "*determin[ing] whether to spread at least a portion of communications to said one of the subscriber stations with one of the orthogonal codes assigned*".

The Office Action then alleges:

*Gopalakrishnan et al. ... teach determining whether to spread at least a portion of communications to said one of the subscriber stations with one of the orthogonal codes assigned to said one of the groups as a function of the data rate ("identifies a subset of standardized data rates using the available power and available Walsh code information received", and "the supportable data rate is not*

only a function of the available SNR but also the available Walsh codes”; Fig. 7, Fig. 8; col. 2, lines 61-67, col. 3, lines 1-8; col. 5, lines 10-14). (Office Action, p. 4; emphasis added).

Applicant respectfully disagrees with the characterization of the actual teaching of Gopalakrishnan. Generally, Applicant’s claimed “determin[ing]” step recites an ordering that is different from the alleged teachings of Gopalakrishnan. Specifically, Applicant’s “determin[ing]” step recites, *inter alia*, (1) “**orthogonal codes assigned ... as a function of the data rate**” and **then** (2) “**determin[ing] whether to spread at least a portion of *communications* to said to one of the subscriber stations *with one of the orthogonal codes assigned***”. In contrast, Gopalakrishnan teaches (1) the “*mobile data unit is informed of ... the number of Walsh codes available*”, and **then** (2) the “*mobile unit identifies ... data rates using the ... available Walsh code information*”, and **then** (3) the “*mobile unit selects a standardized data rate ... [and] communicates its data rate*”. (Gopalakrishnan; col. 2, line 61-col. 3, line 8; emphasis added).

Clearly Applicant’s “determin[ing]” element as conceded by the Examiner as not being taught in the Scherzer and Kim references, of (1) “orthogonal codes assigned ... as a function of the data rate” and **then** (2) “**determin[ing] whether to spread ... communications ... with one of the orthogonal codes assigned**”, **cannot** be taught by Gopalakrishnan’s differently ordered disclosure of (1) the mobile data unit being informed of available Walsh codes, and **then** (2) identifying data rates using the available Walsh code information, and **then** (3) selecting a data rate that is communicated to the base station.

Therefore, since neither Scherzer nor Kim nor Gopalakrishnan teach Applicant’s claimed invention including “**determin[ing] whether to spread at least a portion of *communications* to said to one of the subscriber stations *with one of the orthogonal codes assigned* to said one of the groups *as a function of the data rate*””, these references, either individually or in any proper combination, **cannot** render obvious, under 35 U.S.C. §103, Applicant’s invention as presently claimed in independent claims 1, 6, 17 and 29. Accordingly, Applicant respectfully requests the rejection of independent claims 1, 6, 17 and 29 be withdrawn.**

The nonobviousness of independent claims 1, 6 and 29 precludes a rejection of claims 2-5 and 8, 9, 12-16 and 30-33 which variously depend therefrom because a dependent claim is

obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claims 1, 6 and 29 and claims 2-5 and 8, 9, 12-16 and 30-33 which variously depend therefrom.

### 35 U.S.C. § 102(e) Anticipation Rejections

#### Anticipation Rejection Based on Kim

Claims 34 and 36 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kim. Applicant respectfully traverses this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant submits that Kim does not and cannot anticipate under 35 U.S.C. § 102 the presently claimed invention of independent claim 34 and claim 36 depending therefrom, because Kim does not describe, either expressly or inherently, the identical inventions in as complete detail as are contained in the claims.

The Office Action alleges:

Regarding claim 34, Kim et al. disclose ...a dedicated orthogonal code for a dedicated traffic channel where the length of the dedicated orthogonal code supports a first data rate less than a full data rate of a subscriber station (*col. 4, lines 49-53; col. 7, lines 37-42*); and receiving an assignment of a plurality of orthogonal codes supports a second data rate adequate to handle an overflow up to the full data rate of the subscriber station (1/2 rate; supports a second data rate; *col. 6, lines 40-47, col. 8, lines 4-21*). (Office Action, pp. 11-12; emphasis added).

Applicant respectfully reminds the Examiner that a proper anticipation rejection under 35 U.S.C. § 102 requires that the cited reference must describe the identical invention in as complete detail as contained in the claim. In the present rejection, the citations to Kim at column 4, lines 49-53 and column 6, lines 40-47, disclose *fundamental and supplemental channels on a*

*forward link* while the citation to Kim at column 7, lines 37-42 and column 8, lines 4-21, disclose a *variable data rate voice fundamental channel on a reverse link*.

However, Applicant's independent claim 34, recites, *inter alia*, "receiving a dedicated orthogonal code for *a dedicated traffic channel* wherein a length of the dedicated orthogonal code *supports a first data rate less than a full data rate* of a subscriber station; and receiving an assignment of a plurality of orthogonal codes for *supplemental traffic channels* wherein a length of at least one of the plurality of orthogonal codes *supports a second data rate adequate to handle an overflow up to the full data rate* of the subscriber station." Clearly the citations in Kim do not disclose in as complete detail as claimed by Applicant a "*a dedicated traffic channel ... supports a first data rate less than a full data rate ... and ... supplemental traffic channels ... supports a second data rate adequate to handle an overflow up to the full data rate*".

Therefore, independent claim 34 and claim 36 depending therefrom, cannot be anticipated by Kim under 35 U.S.C. § 102. Accordingly, such claims are allowable over the cited prior art and Applicant respectfully requests that such rejections be withdrawn.

#### **Objections to Claims 7, 10 and 11/Allowable Subject Matter**

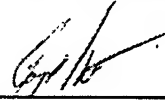
Claims 7, 10 and 11 stand objected to as being dependent upon rejected base claims, but are indicated to contain allowable subject matter and would be allowable if placed in appropriate independent form. Applicant acknowledges this indication with appreciation, but respectfully asserts that the claims in their present form, along with all other claims presently under consideration, are in condition for allowance.

**CONCLUSION**

Claims 1-17 and 29-36 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicant's undersigned attorney.

Respectfully submitted,

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